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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,583	08/19/2003	Tadanobu Sato	Q76907	2930

7590 06/22/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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Washington, DC 20037

EXAMINER

WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,583

Applicant(s)

SATO ET AL.

Examiner

Amanda C Walke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-11 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/987399.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 8/19/03.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____

DETAILED ACTION

Priority

1. This application appears to be a division of Application No. 09/987399, filed 11/14/2001.

A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.

2. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/987399, filed on 11/14/2001. *Specification*

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

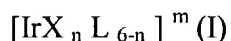
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6, 638,702 (Sato et al) in view of Edwards et al (5,792,601).

Sato et al claims a silver halide emulsion having a silver chloride content ratio of 95% or more comprising silver halide grains containing three or more kinds of transition metal complexes each having a different electron-releasing time respectively classified into any of Class A (100 seconds or more), Class B (more than 1/10 seconds and less than 100 seconds), Class C (more than 1/1000 seconds and 1/10 seconds or less) and Class D (1/1000 seconds or less), wherein at least one of the three or more kinds of transition metal complexes contained in the silver halide grains is a transition metal complex classified in Class C, and further at least one of the three or more kinds of transition metal complexes contained in the silver halide grains is a transition metal complex classified in Class D. Furthermore, the reference claims a silver halide emulsion wherein at least one of the three or more kinds of transition metal complexes contained in the silver halide grains is an iridium complex or a ruthenium complex having at least one halogen ion as its ligand, and wherein the Class C complex contained in the silver halide grains is iridium complex represented by General Formula (I):



wherein X represents a halogen ion, L represents an inorganic compound except halogen or an organic compound, n represents 4 or 5, and m represents an integer of from -4 to +2. The reference claims grains having a silver chloride content ratio of 95% or more, however, the reference fails to claim the presence of either silver iodochloride or silver bromide phase on the grains.

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Edwards et al teaches a high chloride emulsion comprising iodochloride {100} grains, wherein there is a high iodide iodochloride region of the grains. This region is located preferably in the exterior 15 % portion of the grains. Additionally, iridium doped AgBr Lippman emulsions are added to form bromide epitaxial deposits on the surface of the grains (column 6, line 15-column 10, line 21). The presence of both the high iodide iodochloride region of the grains and the doped silver bromide epitaxial deposits result in an increase in sensitivity and contrast.

Given the teachings of the Edwards et al reference, it would have been obvious to one of ordinary skill in the art to prepare the high chloride grains of Sato et al choosing to add both a high iodide iodochloride region in the grains and the doped silver bromide epitaxial deposits of Edwards et al with reasonable expectation of achieving a high chloride emulsion having an increase in sensitivity and contrast.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mydlarz et al (5,783,373 or 5,783,378; column and line citations are for the '373 reference) in view of Edwards et al.

Edwards et al has been discussed above.

Mydlarz et al disclose a silver halide photographic material comprising high chloride grains that have been doped with a combination of three dopants which fall within the scope of the present claim limitations. The class (i) dopants fall within the scope of the present class A, the class (ii) dopants fall within the scope of the present classes C and D, and the class (iii) dopants fall within the scope of the present class B (see column 6, line 3 to column 7, line 40, column 12, line 5 to column 14, line 46). For the class (i) dopants, see especially compound i-1, i-4, and i-6, for the class (ii) dopants ii-15, ii-20, and ii-25 (present class C), and ii-1, ii-2 and ii-4 (present class D), and for the class (iii) dopants iii-1 and iii-2. Although the reference does not provide information regarding the electron-release time, it is believed that the dopants of the reference will inherently meet these limitations because they are all listed as being preferred by the present specification.

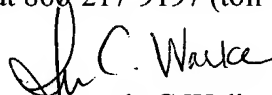
Given the teachings of the Edwards et al reference, it would have been obvious to one of ordinary skill in the art to prepare the high chloride grains of Mydlarz et al choosing to add both a high iodide iodochloride region in the grains and the doped silver bromide epitaxial deposits of Edwards et al with reasonable expectation of achieving a high chloride emulsion having an increase in sensitivity and contrast.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 571-272-1337. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Amanda C Walke
Examiner
Art Unit 1752

ACW
June 20,2004